

REMARKS

Claims 1 – 16 are pending, and claims 1 – 16 stand rejected. The applicant respectively traverses the rejection and request allowance of claims 1 – 16.

Claims 1- 16 are rejected under 35 U.S.C 101 as being directed to non-statutory subject matter. The examiner stated that claims 1 – 16 lacked sufficient technology and that “the PTO requires references to a computer both in the preamble and in the body of the claim.” This rejection has no bases in law. A method claim is not required to reference a computer, either in the preamble or in the body of the claim. Claim 1 is a method claim. Please cite an MPEP section supporting your rejection or a section of 35 U.S.C. that supports your rejection, otherwise withdraw the rejection.

Even if/when the method of claim 1 is implemented as a computer program, claim 1 has the limitation that the method is preformed in a billing system for a communication network. “When a computer program is claimed as part of an otherwise statutory manufacture or machine, the claim remains statutory irrespective of the fact that a computer program is included in the claim... Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence non-statutory.” MPEP 2106 IVA1(a). Claim 1 is a method of billing in a billing system for a communication network. A communication network is certainly a statutory machine. Therefore, even if/when a computer program is used to generate the invoice, the claim remains statutory subject matter.

Claims 1- 16 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as their invention. Claim 1 requires:

1. A method of billing, the method comprising:

in a billing system for a communication network, generating account information related to provisioning a communication service from a third party network for a customer;

receiving network information from the communication network into the billing system;

in the billing system, processing the network information to determine network charges related to usage of the communication network by the customer;

receiving third party information from the third party network into the billing system;

in the billing system, processing the third party information to identify the account information and determine third party charges related to usage of the third party network by the customer;

in the billing system, calculating a single invoice for the customer that includes the network charges and third party charges; and

in the billing system, generating the single invoice. (underlines added)

The examiner states that "the step of processing network information to determine network charges is vague and indefinite." The claims are not read in a vacuum, the claims are read in light of the teaching in the specification and the knowledge for one of ordinary skill in the prior art. "In rejecting a claim under the second paragraph of 35 USC 112, it is incumbent on the examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been

able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims." *Ex parte Wu*, 10 USPQ 2d 2031, 2033 (B.P.A.I. 1989) (underline added).

Here, the specification lists numerous example embodiments where network information is processed to determine network charges. For example, on page 8 lines 28 – 32 it stated that the system "applies all account level monthly recurring charges, non-recurring charges, and usage charges...", these are obviously pieces of network information being processed to determine what the charges to the customer should be for using or renting the network equipment. When reading claim 1 in light of the specification, it is clear that "processing network information to determine network charges" is not vague or indefinite.

The examiner also states that "the step of determining is unclear" in the following line of claim 1. "processing the third party information to identify the account information and determine third party charges related to usage of the third party network by the customer" (Underline added). The dictionary definition for "determine" is: To establish or ascertain definitely, as after consideration, investigation, or calculation. It's clear that the amount to charge a customer for their usage of the third party network is being calculated or established. For example, "the IPS module determines the rate for the service associated with each voucher charge and applies the appropriate unit charge, ... for each pager package" (page 16, lines 1 – 6). Again, it's quite clear that determine is using the ordinary dictionary definition. Therefore claim 1 is allowable as written.

Claims 2 – 8 are dependent on allowable claim 1 and are therefore allowable.

Claim 9 stands rejected under 35 U.S.C 112, second paragraph. The examiner

states that a billing system is unclear because a system can read on both a method or an apparatus. A method claim is a claim for a combination of steps, an apparatus claim is a claim for a combination of elements. Claim 1 lists a number of steps to perform (receiving information, processing information, etc.) and is a method claim. In contrast, claim 9 lists a number of elements that comprise the billing system (a call processing system, an invoice system). Claim 9 is therefore an apparatus claim and allowable as written.

Claims 10 - 16 are dependent on allowable claim 9 and are therefore allowable.

Conclusion

Based on the above remarks, the Applicants submit that claims 1 - 16 are allowable. There may be additional reasons in support of patentability, but such reasons are omitted in the interests of brevity. The Applicants respectfully request allowance of claims 1 - 16.

Any fees may be charged to deposit account 21-0765.

Respectfully submitted,

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